

Serial No.: 09/872,226
Attorney Docket No.: 10008157-1

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REMARKS

In response to the Office Action dated December 12, 2007, claims 1, 10, 19 and 22 have been amended. Claims 1-13, 15-22 and 24 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-13, 15-22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kent (U.S. Patent Publication No. 2002/0040374) in view of Zehr (U.S. Patent Publication No. 2001/0025274) and further in view of Hanson (U.S. Patent No. 5,974,398).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

The Applicants respectfully submit that the combined references do not disclose, teach, or suggest all the features of the claimed invention. For example, the combined references disclose a bidding value that can be established with algebraic formulas and based on age or income profile data (see col. 6, lines 1-5 of Hanson), personalizing and customizing publications using subscriber profile preferences (see Figs. 1-5, paragraphs [0012], [0079], [0083], the Abstract and the Summary of Kent et al.) and automatically reducing the cost of sending an item by inserting advertisements having monetary value (see Abstract, Figs. 2-5, paragraph [0043] and the Summary of Zehr et al.).

In contrast, the Applicants' independent claims now include creating bonus material based on the user's profile and demographic information different from content in the media and the advertisements and automatically including the bonus material in the media, wherein the bonus material includes sample free content related to the

user's interests.

Although the Examiner argued that the combined references disclose a bidding value that can be established with algebraic formulas based on age or income profile data and having an advertiser "bid-up" for a spot, this is very different from the Applicants' previously claimed worth based bidding system using potential values and newly claimed bonus material different from content in the media and the advertisements, created based on the user's profile and demographic information and automatically included in the media, wherein the bonus material **includes sample free content** related to the user's interests.

Specifically, the combined references instead disclose providing an advertising bidding system with algebraic formulas based on user profiles (Hanson) where advertiser's can manually "bid-up" for a spot "...meaning whether an advertiser has indicated within the ad order processor 76 that placement of certain ads to certain types of people are worth more than others" based on their own discretion (see paragraph [0043] of Zehr et al.). This is unlike the Applicants' automatically determining what advertisements, if any, would be worth placing in the media and bonus material as sample free content related to the user's interests and different from content in the media and the advertisements, created based on the user's profile and demographic information and automatically included in the media.

Thus, since the combined references are missing features of the Applicants' claimed invention, the combined references cannot render the Applicants' invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicants' claimed invention indicates a lack of a prima facie case of obviousness and, thus, the rejections should be withdrawn (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the

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amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly request the Examiner to telephone the Applicants' attorney at (818) 885-1575.

Please note that all mail correspondence should continue to be directed to

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Respectfully submitted,
Dated: March 11, 2008



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